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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,748	06/18/2001	Kunio Shiota	04853.0074	8762

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
1300 I STREET, NW
WASHINGTON, DC 20005

EXAMINER

BRUSCA, JOHN S

ART UNIT PAPER NUMBER

1631

DATE MAILED: 05/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/881,748

Applicant(s)

SHIOTA ET AL.

Examiner

John S. Brusca

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 May 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See *Continuation Sheet*.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see note above.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

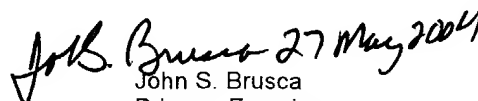
Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1 and 5-13.

Claim(s) withdrawn from consideration: 4 and 14.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 01 December 2003.
10. ☐ Other: _____


John S. Brusca
Primary Examiner
Art Unit: 1631

Continuation of 2. NOTE: The proposed amendment will not be entered after final because the amendment raises new issues and does not place the application in better form for appeal. The proposed amendment is vague in that the proposed new limitation "a plurality of gene regions" could mean either regions within a single gene or a plurality of different genes. The applicants state that Duffy does not anticipate claims 1, 5, 7, and 11 because Duffy does not show obtain a DNA methylation pattern. However Duffy determines a plurality of sites of differential methylation in the examples at columns 21-28 which is all that is required by the instant claims. The applicants state that Duffy does not compare patterns after obtaining patterns as in the proposed amendment. Since the amendment has not been entered, the argument is not persuasive, and it is further not clear why Duffy does not show comparison of patterns after obtaining the pattern data. The applicants state Duffy does not show comparison to known types of cell, tissue, or nucleus, however Duffy compares to normal tissue which meets the limitations of the claims. The applicants state that Zhu does not show a correlation between methylation and phenotype of cells, however table 3 of Zhu shows a correlation between methylation levels and gene expression, and gene expression is a phenotype that is a differentiation state. The applicants state that Hertz does not show aspects of the preamble of claims 1 or 5. The preamble of claims 1 and 5 are not given weight for purposes of anticipation because the preamble does not affect the steps of the claimed method. Hertz shows the steps of the claimed method because Hertz compares the methylation state of different cells at a number of different loci.